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**REMARKS**

Applicants appreciate the Office's review of the present application. In response to the Office Action, the cited references have been reviewed, and the rejections and objections made to the claims by the Examiner have been considered. The claims presently on file in the present application are believed to be patentably distinguishable over the cited references, and therefore allowance of these claims is earnestly solicited.

In order to render the claims more clear and definite, and to emphasize the patentable novelty thereof, claims 2 and 40 have been amended. Support for any claim amendments and new claims is found in the specification, claims, and drawings as originally filed, and no new matter has been added. Accordingly, all elected claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested.

Dependent claim 2 has been rewritten in independent form in reliance on the allowability indicated by the Office and only in order to advance prosecution.

**Rejections****Rejection Under 35USC §102**

Claims 1, 9, and 40 have been rejected under 35 USC §102(b), as being anticipated by U.S. patent 6,141,111 to Kato ("Kato"). Applicants respectfully traverse the rejection and request reconsideration based on the amendment to claim 40 and features in the claims which are neither disclosed nor suggested in the cited reference.

As to a rejection under §102, "[a]nticipation is established only when a single prior art reference discloses expressly or under the principles of inherence, each and every element of the claimed invention." *RCA Corp. v. Applied Digital Data Systems, Inc., (1984, CAFC) 221 U.S.P.Q. 385*. The standard for lack of novelty, that is for "anticipation," is one of strict identity. To anticipate a claim, a patent or a single prior art reference must contain all of the essential

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elements of the particular claims. Schroeder v. Owens-Corning Fiberglass Corp., 514 F.2d 901, 185 U.S.P.O. 723 (9th Cir. 1975); and Cool-Fin Elecs. Corp. v. International Elec. Research Corp., 491 F.2d 660, 180 U.S.P.O. 481 (9th Cir. 1974). The identical invention must be shown in as complete detail as is contained in the claim. Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPO2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. In re Bond, 910 F.2d 831, 15 USPO2d 1566 (Fed. Cir. 1990).

The rejection of independent claim 1, and its dependent claim 9, is respectfully traversed at least because the single cited reference does not disclose all of the essential elements of the claims arranged as required by the claims and in as complete detail as in the claims. In this regard, claim 1 recites:

"1. (Original) A method of printing user-selected ones of a collection of images, comprising:

printing a plurality of proof sheets each having a thumbnail representation of at least some of the images, and at least one user-markable field indicative of at least one corresponding image when marked;

optically scanning a plurality of user-marked ones of the proof sheets to detect marked ones of the at least one user-markable field;

processing the marked ones of the fields to determine at least one selected image associated with each scanned proof sheet; and

printing the at least one selected image after the plurality of user-marked proof sheets have been scanned." (emphasis added)

Applicant respectfully believes that this rejection is inadequate to establish a prima facie case of anticipation because the single cited reference does not disclose all of the essential elements of the claims arranged as required by the claims and in as complete detail as in the claims.

The Kato reference discloses an "image processing system" in which

"serviceability and efficiency of the system can be improved by use of an extra-copy designation sheet for designation of various information. Further, it is also possible to improve the management of extra-copy printing [and make] the distribution of extra-copies easy by printing and outputting extra-copies for a plurality of users by sorting them for each bin and

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transmitting image data for extra-copies of a plurality of users to image displays owned by users" (col. 10, ln. 12-22).

In the Kato reference, an extra-copy designation sheet 100 (Fig. 4) is printed by the image printer 26 (col. 6, ln. 17-20). A single extra-copy designation sheet 100 has a matrix arrangement, with a plurality of image index portions 102 (i.e. thumbnail images) in a column along the left border, and a plurality of user ID input portions 101 (for identification of different users) in a row along the top border. Within the matrix are extra-copy check portions 103 by which an operator can indicate that a copy of the associated image is to be printed (or delivered by email) to the corresponding user. As illustrated in the flowchart of Fig. 5, the extra-copy designation sheet 100 is marked by a user or operator, and then inserted into the image printer again (col. 6, ln. 17-25). The inserted sheet 100 is read by the scanner 3 (Fig. 1). The image printer then recognizes the image index portions 102, and the data entered by the operator for the various user ID input portions 101 and the corresponding extra-copy check portions 103 and, based on the entered data, prints and sorts (or delivers by email) the images selected for each user (col. 6, ln. 26-51).

This is significantly different from the invention recited in claim 1. In claim 1, a plurality of proof sheets, rather than just a single proof sheet as in the Kato reference, is printed. Then a plurality of the user-marked ones of the proof sheets are scanned and processed to determine at least one selected image associated with each scanned proof sheet. Finally, the at least one selected image is printed after the plurality of user-marked proof sheets have been scanned. Even if the Kato reference were somehow to be construed as disclosing the printing of a plurality of proof sheets, there is no disclosure in the Kato reference that the selected images on the user-marked proof sheets are not printed until after the plurality of user-marked proof sheets have been scanned. Conversely, the Kato reference discloses the opposite: that the images are printed/sorted (or emailed) each time an extra-copy designation sheet 100 is inserted in, and recognized by, the image printer. There is no disclosure in the Kato reference that the processing of selected images from one extra-copy designation sheet 100 is delayed until one or more

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additional extra-copy designation sheets 100 are inserted into the image printer.

The novel features of the present invention are not anticipated by the Kato reference in that the above-discussed essential elements, arranged as required by the claim and recited in as complete detail as in the claim, is absent from the reference. Therefore, the rejection is improper at least for that reason and should be withdrawn.

The rejection of independent claim 40 is respectfully traversed at least because the single cited reference does not disclose all of the essential elements of the claims arranged as required by the claims and in as complete detail as in the claims. In this regard, claim 40 recites:

"40. (Currently amended) A method of printing subsets of images selected from a collection of images, comprising:

identifying the images in the collection;  
printing a plurality of proof sets, each proof set including a proof sheet having a thumbnail representation of each image and at least one user-markable field associated with at least one of the thumbnail representations;  
distributing each proof set to a different user, each user marking desired ones of the fields so as to define one of the subsets;  
retrieving the user-marked proof sets;  
optically scanning the proof sheets of the retrieved proof sets to detect the user-marked fields;  
processing the user-marked fields to determine the images in the subsets;  
collating the subsets to determine, for each image, a corresponding number of copies to be printed according to a particular set of print characteristics; and  
after the collating, printing the corresponding number of copies of each image according to the corresponding particular set of print characteristics."

(emphasis added)

Applicant respectfully believes that this rejection is inadequate to establish a prima facie case of anticipation because the single cited reference does not disclose all of the essential elements of the claims arranged as required by the claims and in as complete detail as in the claims.

For similar reasons as have been discussed heretofore with regard to claim 1, the Kato reference does not disclose printing a plurality of proof sets, each proof set including a proof sheet.

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In addition, because the Kato reference does not disclose a plurality of proof sets, it cannot disclose distributing each proof set to a different user. In fact, Kato discloses that all the fields on the proof sheet, though it may be used to send extra copies to several different users, are filled in by one single person, the operator (col. 6, ln. 21-25).

Further, the Kato reference fails to disclose the limitations of the collating and printing steps. The collating step recites that the various subsets (of user-desired images, defined by the fields on the proof sheets marked by the different users) are collated to determine, for each image, a corresponding number of copies to be printed according to a particular set of print characteristics, and the subsequent printing step recites that the corresponding number of copies of each image, as determined by the collating step, are then printed. Because the Kato reference merely discloses printing (or emailing) images based on processing a single proof sheet, it fails to disclose any such collation of markings entered on multiple proof sheets prior to printing user-selected images.

It is also noted that, because the Kato reference uses only a single proof sheet, whose fields are filled in by a single operator, it would be inadequate to solve the problems discussed in Applicants' invention:

"A collection of photographs are often taken at significant events that are attended by a number of persons. Examples of such events may include weddings, family parties, business conferences, and organized trips, while the photographs may be taken by professional photographers and/or some of the attendees. Many of the attendees may desire to obtain their own printed copies of certain ones of these photos.

However, the process of having a large number of people review the photos and make their selections, and having another person or business organize, procure, and distribute the printed copies can be cumbersome and time consuming. Further complicating matters, some purchasers may be willing to spend only a limited amount of money on purchasing the printed copies. Additionally, in some cases a purchaser may lose their printed copies and desire replacements, or wish to procure another set for a friend or relative. For these and other reasons, there is a need for the present invention." (para. [0002]-[0003]; emphasis added)

Although the single proof sheet disclosed in the Kato reference allows images to be specified for a plurality of users, it would be inadequate to solve the above-stated problems for

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several reasons. First, sequentially shipping a single proof sheet from one user to another would take extra time, compared to shipping multiple copies in parallel to each user. Second, it is more likely that the single proof sheet could get lost or discarded in shipping among multiple persons and locations than if it only had to be sent back to the original sender. Third, one user might fail to send it back to the original sender or to the next user, which would prevent any of the users from receiving their desired photos since the proof sheet would never be returned to the printing system. Such problems do not occur with the present invention, in which individual proof sets can be distributed in parallel to each user.

The novel features of the present invention are not anticipated by the Kato reference in that the above-discussed essential elements, arranged as required by the claim and recited in as complete detail as in the claim, is absent from the reference. Therefore, the rejection is improper at least for that reason and should be withdrawn.

Rejection Under 35USC §103

Claim 41 has been rejected under 35 USC §103(a), as being unpatentable over U.S. patent 6,141,111 to Kato ("Kato") in view of U.S. patent 5,359,387 to Hicks ("Hicks").

Applicants respectfully traverse the rejection and request reconsideration at least based on the dependence of these claims on independent claim 40, whose reasons for allowability over the Kato reference have been discussed heretofore and against which the Hicks reference has not been cited. In addition, the reason articulated by the Office for combining the prior art elements in the manner claimed lacks a rational underpinning that would have prompted a person of ordinary skill in the relevant field to make the modification. Accordingly, the Office impermissibly uses the Applicants' disclosure as a blueprint or in hindsight for the rejection. Therefore, the rejection is improper at least for these reasons and should be withdrawn.

Claim 42 has been rejected under 35 USC §103(a), as being unpatentable over U.S. patent 6,141,111 to Kato ("Kato") in view of U.S. patent 6,623,528 to Squilla et al. ("Squilla").

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Applicants respectfully traverse the rejection and request reconsideration at least based on the dependence of these claims on independent claim 40, whose reasons for allowability over the Kato reference have been discussed heretofore and against which the Hicks reference has not been cited. In addition, the reason articulated by the Office for combining the prior art elements in the manner claimed lacks a rational underpinning that would have prompted a person of ordinary skill in the relevant field to make the modification. Accordingly, the Office impermissibly uses the Applicants' disclosure as a blueprint or in hindsight for the rejection. Therefore, the rejection is improper at least for these reasons and should be withdrawn.

Formalities

Allowable Subject Matter

Applicants acknowledge, with appreciation, the allowance of claims 10-17.

Claims 2-6 have been objected to as being dependent upon a rejected base claim and have been indicated as being allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. With this Amendment, Applicants have rewritten allowable claim 2 in independent form to include all of the limitations of the base claim (claim 1) and any intervening claims (none). As rewritten claim 2 is now believed to be in allowable form, Applicants submit that dependent claims 3-6 are allowable in dependent form. Applicants, therefore, respectfully request that the objection to claims 2-6 be withdrawn and that claims 2-6 be deemed allowed.

Rejoinder of Dependent Claims to Non-Elected Species

Dependent claims 7-8, drawn to non-elected species, were previously withdrawn. In response to the prior restriction requirement, Applicants requested that claim 1 be designated as generic. Because the limitations of generic claim 1 have been added to allowable claim 2 as rewritten, and because previously withdrawn claims 7-8 depend from claim 2, withdrawal of the

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restriction requirement and rejoinder of claims 7-8 is respectfully requested.

Comments on Statement of Reasons for Allowance

Applicants agree with the Office's conclusion regarding patentability, without necessarily agreeing with or acquiescing in the reason(s) set forth in the Office Action. In particular, Applicants wish to emphasize that the patentability of claims stems from the respective combinations of elements defined by the claims, each viewed as a whole, rather than the presence of any particular element(s) in the combinations. Applicants submit that the indicated claims are allowable because the prior art fails to anticipate, teach, suggest, or render obvious the invention as claimed, independent of how the invention is paraphrased. Applicants thus rely on the claims, as drafted, rather than any characterization in the Office Action.

Conclusion

Attorney for Applicants has reviewed each one of the cited references made of record and not relied upon, and believes that the claims presently on file in the subject application patentably distinguish thereover, either taken alone or in combination with one another.

Therefore, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested. If it is felt for any reason that direct communication with Applicant's attorney would serve to advance prosecution of this case to finality, the Examiner is invited to call the undersigned Robert C. Sismilich, Esq. at the below-listed telephone number.

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Respectfully submitted,



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